

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Final Office Action dated October 3, 2008, is respectfully requested in view of this amendment.

Claims 11 and 24 have been amended. In this regard, Applicant notes that the amended claims merely clarify the subject matter recited in the rejected claims. Claims 1-13 and 18-27 are pending in this application.

In the outstanding Office Action, the Examiner rejected claims 11-13 and 18-21 under 35 U.S.C. §101, asserting that the claimed invention is directed to non-statutory subject matter; rejected claims 1, 8, 11, 22, 25 and 26 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 6,557,009 to Singer et al. (hereinafter referred to as “the Singer et al. ‘009 patent”); rejected claims 2-7, 12, 13, 19, 24 and 27 under 35 U.S.C. §103(a) as being unpatentable over the Singer et al. ‘009 patent in view of U.S. Patent Application Publication No. 2003/0167187 to Bua (hereinafter referred to as “the Bua ‘187 publication”); rejected claims 9, 10 and 18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,590,057 to Fletcher et al. (hereinafter referred to as “the Fletcher et al. ‘057 patent”); and rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over the Singer et al. ‘009 patent and U.S. Patent No. 6,546,230 to Allison (hereinafter referred to as “the Allison ‘230 patent”).

By this Response and Amendment, responsive to the Examiner’s 35 U.S.C. §101 rejections, claim 11 has been amended to clarify the claimed subject matter intended by the Applicant and clarify the statutory subject matter directed to herein. Support for the amendments can be found throughout the original specification and claims. Claim 24 has been amended to correct a typographical error, to change the dependency of the claim from dependent claim 23 to independent claim 22.

It is respectfully submitted that the above amendments introduce no new matter within the meaning of 35 U.S.C. §132.

Claim Rejections under 35 U.S.C. §101

The Examiner rejected claims 11-13 and 18-21 under 35 U.S.C. §101 asserting that the claimed invention is directed to non-statutory subject matter. In particular, the Examiner asserted that the claimed invention [claimed method] does not have a sufficient tie to any machine, article of manufacture or a composition of matter.

Response

Claims 11-13 and 18-21 have been amended or depend from amended claims and, as amended, the rejections thereto are respectfully traversed. The claims, as presented, are believed to embody statutory subject matter. In particular, the claims describe functional structures or changes as required under 35 U.S.C. § 101.

In order to satisfy the issue of whether a claimed method is a patent-eligible or statutory “process,” as defined in 35 U.S.C. §101, the Federal Circuit, relying on a detailed analysis of Supreme Court precedent, articulated a “machine or transformation test” for patentability. “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski* 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008); MPEP §2106.

Applicant respectfully disagrees with the Examiner’s 35 U.S.C. §101 rejection of independent claim 11 and claims 12, 13 and 18-21, dependent therefrom. Applicant respectfully submits that, in contrast to the Examiner’s assertions, the claimed subject matter is clearly tied to a computer or other digital information communication machine(s), at least evidenced by the claim terms “computer-implemented,” “graphical user interface,” “communication network,” etc.

However, solely for the purpose of advancing prosecution, Applicant has amended claim 11 to further clarify and reinforce the ties that the claimed subject matter has to machine(s), article of manufacture(s), etc. By this Response and Amendment, claim 11 has been amended to further reinforce that the claimed computer-implemented method for allowing users to remotely perform assessments for compliance certification, operates via a graphical user interface. Support for the amendment may be found throughout the original and previously presented claims and at

least beginning on page 8, line 19, of the original specification.

Thus, Applicant further reinforces the ties between the claimed subject matter to a machine, article of manufacture or a composition of matter, as required and discussed in the Examiner cited *In re Comiskey* and in the recent *In re Bilski*.

The method described by claims 11-13 and 18-21 (and claim 26, also dependent upon amended claim 11) comprises certain tangible steps selected, coupled and configured in accordance with certain embodiments of the presently claimed subject matter. The amended claim 11 is believed to fully address the issues of statutory subject matter under 35 USC 101, and the "practical application" requirement, which was not a basis of rejection by the Examiner.

As amended, claim 11 recites, *inter alia*:

A computer-implemented method for allowing users to remotely perform assessments for compliance certification via a graphical user interface on a network access device, comprising the steps of:

storing a plurality of evaluation questions and a plurality of assessment questions,

wherein the evaluation questions ask for information usable to construct profiles of at least one organization,

wherein the assessment questions ask for information usable to determine if said at least one organization meets requirements for at least one compliance certification, and

wherein subsets of said plurality of evaluation and assessment questions are combinable to form a plurality of assessment courses;

causing a graphical user interface to be displayed on a network access device, over a communications network, to an assessed user, as individual personnel of an organization seeking said at least one compliance certification;

receiving a selection from said assessed user, via said graphical user interface on a network access device, wherein said selection is indicative of one of said plurality of assessment courses..."

Applicant requests reconsideration of the rejections and respectfully submits that the rejections under 35 U.S.C. 101 should be withdrawn.

Claim Rejections under 35 U.S.C. §102(b)

The Examiner rejected claims 1, 8, 11, 22, 25 and 26 under 35 U.S.C. §102(b) as being unpatentable over the Singer et al. '009 patent.

Response

Claims 11 and 26 have been amended, as discussed above, or depend upon amended claims and, as amended, the rejections thereto are respectfully traversed. Applicant respectfully traverses the remaining rejections since all of the features of the presently claimed subject matter are not disclosed by the cited references.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Overview

Applicant's independent claim 1 sets forth:

"A system for allowing a user to perform an assessment for compliance certification comprising:

a database storing a plurality of evaluation questions and a plurality of assessment questions,

wherein the evaluation questions ask for information usable to construct profiles of at least one organization,

wherein the assessment questions ask for information usable to determine if said at least one organization meets requirements for at least one compliance certification, and

wherein subsets of said plurality of evaluation and assessment questions are combinable to form a plurality of assessment courses; and

a server, connected to said database via a communications network, having a processor configured to cause a graphical user interface to be displayed to a network access device connected to said server via said communications network;

wherein said processor is further configured to present to an assessed user, as individual personnel of an organization seeking said at least one compliance certification, via said graphical user interface, a subset of evaluation questions comprised by at least one of said plurality of assessment courses,

wherein said processor is further configured to receive responses from the assessed user to said subset of evaluation questions,

wherein said processor is further configured to construct at least one profile of the organization seeking said at least one compliance certification based on said responses to said subset of evaluation questions,

wherein said processor is further configured to present to the assessed user, via said graphical user interface, a subset of assessment questions comprised by said at least one of said plurality of assessment courses and corresponding to said at least one profile of the organization seeking said at least one compliance certification, and

wherein said processor is further configured to receive responses from the assessed user to the subset of assessment questions comprising said at least one of said plurality of assessment courses.”

Amended independent claim 11 has been discussed above, and recites:

“A computer-implemented method for allowing users to remotely perform assessments for compliance certification via a graphical user interface on a network access device, comprising the steps of:

storing a plurality of evaluation questions and a plurality of assessment questions, wherein the evaluation questions ask for information usable to construct profiles of at least one organization,

wherein the assessment questions ask for information usable to determine if said at least one organization meets requirements for at least one compliance certification, and

wherein subsets of said plurality of evaluation and assessment questions are combinable to form a plurality of assessment courses;

causing a graphical user interface to be displayed on a network access device, over a communications network, to an assessed user, as individual personnel of an organization seeking said at least one compliance certification;

receiving a selection from said assessed user, via said graphical user interface on a network access device, wherein said selection is indicative of one of said plurality of assessment courses;

presenting to said assessed user, via said graphical user interface, a subset of evaluation questions comprised by at least one of said plurality of assessment courses;

receiving from said assessed user, via said graphical user interface, responses to said subset of evaluation questions;

constructing at least one profile of the organization seeking said at least one compliance certification based on said responses to said subset of evaluation questions,

presenting to said assessed user, via said graphical user interface, a subset of assessment questions comprised by said at least one of said plurality of assessment courses and corresponding to said at least one profile of the organization seeking said at least one compliance certification;

receiving from said assessed user, via said graphical user interface, responses to the subset of assessment questions comprised by said at least one of said plurality of assessment courses.”

Applicant’s independent claim 22 recites:

“A computer program product comprising a computer usable medium having control logic stored therein for causing a computer to perform assessments for compliance certification, said control logic comprising:

first computer readable program code means for causing the computer to store a plurality of evaluation questions and a plurality of assessment questions,

wherein the evaluation questions ask for information usable to construct profiles of at least one organization,

wherein the assessment questions ask for information usable to determine if said at least one organization meet requirements for at least one compliance certification, and

wherein subsets of said plurality of evaluation and assessment questions are combinable to form a plurality of assessment courses;

second computer readable program code means for causing the computer to display a graphical user interface, over a communications network, to an assessed user as individual personnel of an organization seeking said at least one compliance certification;

third computer readable program code means for causing the computer to receive a selection from said assessed user, via said graphical user interface, wherein said selection is indicative of one of said plurality of assessment courses;

fourth computer readable program code means for causing the computer to present to said assessed user, via said graphical user interface, a subset of evaluation questions comprised by at least one of said plurality of assessment courses;

fifth computer readable program code means for causing the computer to receive from said assessed user, via said graphical user interface, responses to said subset of evaluation questions;

sixth computer readable program code means for causing the computer to construct at least one profile of the organization seeking said at least one compliance certification based on said responses to said subset of evaluation questions;

seventh computer readable program code means for causing the computer to present to said assessed user, via said graphical user interface, a subset of assessment questions comprised by said at least one of said plurality of assessment courses and corresponding to said at least one profile of the organization seeking said at least one compliance certification;

eighth computer readable program code means for causing the computer to receive from said assessed user, via said graphical user interface, responses to the subset of assessment questions comprised by said at least one of said plurality of assessment courses.”

The Singer et al. ‘009 patent abstract discloses “[A] system ... that allows remote, regulated entity users web based access to authorization data, such as permit data in an environmental regulatory permitting or management system. The user can enter, edit and submit permit and compliance data in the environmental permitting system controlled by a regulating agency in real-time via a web browser over the Internet. The system can also validate submitted information in real-time and allows the user to correct the data. Electronic certification with a unique signature is also performed. Fee payment can be made electronically in real-time through the permitting system with an electronic payments system with a corresponding credit being made to the relevant department general ledger account.”

Rejection of claims 1, 8, 11, 22, 25 and 26

The Examiner has asserted that “the reference database storing a plurality of evaluation question and plurality of assessment question” introduced in Claims 1, 11 and 22 of the presently claimed subject matter is disclosed by the Singer et al. ‘009 patent (col. 5, lines 55-68, Applicant citation of line 54 for clarity included in braces) as an “{application server 16...

[which]}communicate[s] between the web server 14 and a joint usage database 18 located on a database server 19. The application server 16 takes requests from users, accesses information needed by the users within the database 18 and sends that data to the web server 14 to be formatted into a web page. This web page is sent to the PC 12.”

However, Applicant respectfully submits that the Singer et al. ‘009 patent fails to disclose or enable a “database storing a plurality of evaluation question and plurality of assessment question” as recited in the claims. Indeed, the cited passage of the Singer et al. ‘009 patent above fails to discuss any sort of evaluation or assessment question stored, much less a database containing a plurality of such questions.

The Examiner has further asserted that “wherein the evaluation questions ask for information usable to construct profiles of at least one organization” is disclosed by the Singer et al. ‘009 patent (col. 9, lines 20-30, Applicant citation of line 19 for clarity included in braces) as “{the user accesses 302 (see FIG. 8) the} spread-sheet submittal web pages (see FIGS. 6A-6C). In this page 264 the user enters 304 contact information, typically an address information including an e-mail address as depicted in FIGS. 6Ai and 6Aii, enters 306 facility and equipment identification information in page 266 as depicted in FIGS. 6Bi and 6Bii and enters 308 reporting period data in page 268 as depicted in FIG. 5C. The user then submits 310 the completed request to the application server 16 through the web server 14.”

Again, the Singer et al. ‘009 patent fails to discuss (explicit) evaluation questions. Instead, the submittal web pages discussed in the cited passage merely consist of form fields for entering standard *contact* or *identification information* (as shown in Figs. 6Ai and 6Aii), similar to those that the applicant would ordinarily complete in paper form but instead, in the Singer et al. ‘009 patent application, completes in web form. Thus the ‘profile’ created in the Singer et al. ‘009 patent is superficial at best and not derived from answers to evaluation questions, of which there are none. In contrast, the presently claimed subject matter refers to the development of profile(s) regarding the organization or laboratory being assessed for compliance. Page 13, lines 3-9 of the original specification clarify that “[I]n step 208, process 200 constructs a Laboratory Profile by asking a series of evaluation questions. Examples of information collected during step

208 are tests performed, specialties, instruments, personnel, and proficiency testing. This information is then used in the self-assessment course to determine which (appropriate) questions would be shown to the user. For example, if the specialty of microbiology is not conducted in the laboratory, the user would not be presented (i.e., would not have to answer) any microbiology-related self-assessment questions.” Thus, the specification reinforces the interactive relationship recited in the claims wherein evaluation questions are asked and the answers given by the user are used to construct a profile(s) for the organization or laboratory being assessed.

In further contrast, lines 28-38 of the Singer et al. ‘009 patent state that “[B]ecause the preparation of the *spread-sheet* can take a short period of time, the spread-sheet can be and typically is prepared at the server level and is *"off-line" from the user's interaction taking place with the permitting system web site* on the client machine. As a result, when the user submits the request, the user need not wait for the spread-sheet to be created and can do other things. Of course, it is also possible for the user to wait and refresh the application screens in real-time so that the user can have access to the spread sheet as soon as possible if desired.” Thus, not only does the Singer et al. ‘009 patent merely produce a spreadsheet for data entry, but there is no interaction or enablement of interaction between the user, the server and the resulting spread-sheet in constructing a profile from the user’s answers to evaluation questions.

The Examiner has further asserted that “wherein the assessment questions ask for information usable to determine if said at least one organization meet requirements for at least one compliance certification” is disclosed by the Singer et al. ‘009 patent (col. 8, lines 1-15) as “The system then queries 132 as to whether the individual is the responsible official. If so a second responsible official certification screen 212 (see FIG. 3Eii) for the official is presented showing all of the permits that are in the officials's queue. A responsible official may also access the responsible official certification screen at any point in the process through the web portal's menu. The official can select 136 (see FIG. 2D) to review 138 one or more of the permits. If the official has reviewed the permit and desires to certify it, the official enters his PIN electronically signing 140 the permit and submits the certification. The system then validates 142, at the application server level against the central data repository, the signature using the database 18 to

compare the entered PIN with valid PINs stored in the database 18 and initiates 144 a Java script....”

The Examiner has further asserted that “wherein subsets of said plurality of evaluation and assessment questions are combinable to form a plurality of assessment courses” is disclosed by the Singer et al. ‘009 patent (col. 10, lines 33-40) as “The present invention has been described with respect to environmental-streamlining the transfer of data and permit documents between regulators and their regulated clients as well as making payments therefor. The tool of the present invention could be applied to the creation, electronic certification, printing and payment of any kind of permit document (i.e. permit, application, report, certificate and/or standardized spread-sheet) for electronic submission....”

The Examiner has further asserted that “wherein said processor is further configured to present to an assessed user, as individual personnel of an organization seeking said at least one compliance certification, via said graphical user interface, a subset of evaluation questions comprised by at least one of said plurality of assessment courses” is disclosed by the Singer et al. ‘009 patent (col. 9, lines 20-30) as already discussed above.

Applicant is somewhat confused by the Examiner’s interpretation of the claims. The cited passages of the Singer et al. ‘009 patent not only do not disclose or enable “assessment questions” distinct from evaluation questions, but also do not discuss “requirements for at least one compliance certification” and do not discuss “assessment courses” as recited in the claims. In the presently claimed subject matter, the evaluation questions are used to construct profile(s) for the organization(s) applying for certification and to determine the (types and number, etc. of) assessment courses that will be displayed for the user from the organization to complete. The assessment courses contain assessment questions that must be answered by the user. In contrast, the above passages of the Singer et al. ‘009 patent appear only to allow for the governmental responsible certification official to access a screen 212 to review one or more of the (application(s) for) permits. While Applicant recognizes that the passage in col. 10 of the Singer et al. ‘009 patent provides for application of the “present invention” “to the creation, electronic certification... of any kind of permit document... for electronic submission,” such a statement

does not change the lack of disclosure or enablement in the Singer et al. '009 patent of many features of the Applicant's claimed subject matter. None of the evaluation questions, assessment questions, assessment courses, or the requirements for certification recited in the present claims are disclosed in the above passages, instead only that *if* the official has reviewed the user's (web forms and data spreadsheet) application *and* desires to certify the permit, electronic means are available for doing so.

Finally, the Examiner has further asserted that "wherein said processor is further configured to construct at least one profile of the organization seeking said at least one compliance certification based on said responses to said subset of evaluation questions" is disclosed by the Singer et al. '009 patent (Fig. 3Ci).

As discussed above, Applicant respectfully submits that the Singer et al. '009 patent fails to disclose or enable construction of "at least one profile of the organization... based on said responses to... evaluation questions" as substantially recited in the claims. Fig. 3Ci of the Singer et al. '009 patent reinforces the points discussed by Applicant above, as the figure depicts a screen shot of "Facility Profile" further explained by such text as "Your facility location address and mailing address are displayed" and "You may enter up to three contacts as your Facility Contacts." Applicant notes that no questions are present on the screen, and the profile that is suggested by this page is superficial, not directed to responses of evaluation questions regarding compliance criterion and could not be used to further determine the assessment questions to be asked for compliance certification, in contrast to the presently claimed subject matter.

At least because of the above reasons, independent claims 1, 11 and 22 and claims 8, 25 and 26 dependent therefrom are patentably distinguished over the Singer et al. '009 patent.

Applicant respectfully submits that independent claims 1, 11 and 22 and all the claims depending therefrom are novel, unobvious and consequently patentable over the cited prior art of record. It is therefore respectfully submitted that the rejections under 35 U.S.C. 103(a) should be withdrawn.

Claim Rejections under 35 U.S.C. §103(a)

The Examiner rejected claims 2-7, 12, 13, 19, 24 and 27 under 35 U.S.C. §103(a) as being unpatentable over the Singer et al. '009 patent in view of the Bua '187 publication; rejected claims 9, 10 and 18 under 35 U.S.C. §103(a) as being unpatentable over the Fletcher et al. '057 patent; and rejected claim 20 under 35 U.S.C. §103(a) as being unpatentable over the Singer et al. '009 patent and the Allison '230 patent.

Response

Claims 12, 13, 19 and 24 have been amended or depend upon amended claims and, as amended, the rejections thereto are respectfully traversed. Applicant respectfully traverses the remaining rejections since all of the features of the presently claimed subject matter are not disclosed by the cited references.

In order to establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations.

Applicant respectfully submits that the Bua '187 publication, the Fletcher et al. '057 patent and the Allison '230 patent fail to cure the deficiencies of the Singer et al. '009 patent with respect to the claimed subject matter in accordance with Applicant's independent claims 1, 11 and 21 and further, does not suggest a teaching or motivation to reach such subject matter as claimed in the instant application.

It is at least for these reasons that the cited references (the Singer et al. '009 patent, the Bua '187 publication, the Fletcher et al. '057 patent, and the Allison '230 patent) fail.

Therefore, it is submitted that independent claims 1, 11 and 22 and all the claims depending therefrom are unobvious over the cited prior art of record, whether taken alone or in any combination.

It is therefore respectfully submitted that the rejections under 35 U.S.C. 103(a) should be withdrawn.

CONCLUSION

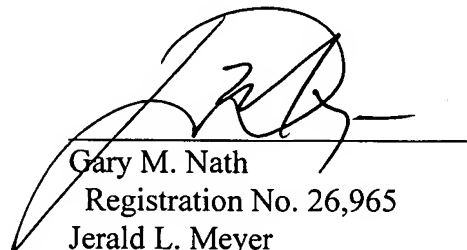
In light of the foregoing, Applicant submits that the application is in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner call the undersigned.

Respectfully submitted,

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